REMARKS/ARGUMENTS

Claims 1-16 are now active in this application.

The indication that claims 4-10 are allowable is acknowledged and appreciated.

REJECTION OF CLAIMS UNDER 35 U.S.C. § 102 AND § 103

I. Claims 1-3 and 11-14 are rejected under 35 U.S.C. § 102(e) as being anticipated by Fujita et al. (USPN 5,872,587).

The rejection of claims 1-3 and 11-14 is respectfully traversed.

The factual determination of lack of novelty under 35 U.S.C. § 102 requires the identical disclosure in a single reference of each element of a claimed invention such that the identically claimed invention is placed into possession of one having ordinary skill in the art. ***Helifix Ltd. v. Blok-Lok, Ltd.***, 208 F.3d 1339, 200 U.S. App. LEXIS 6300, 54 USPQ2d 1299 (Fed. Cir. 2000); ***Electro Medical Systems S.A. v. Cooper Life Sciences, Inc.,*** 34 F.3d 1048, 32 USPQ2d 1017 (Fed. Cir. 1994).

In response to the argument submitted in the Amendment dated August 14, 2003, the Examiner states that "the element is not being turned off when the printing time of the element pass 32" (page 9, lines 18-19). However this teaching of Fujita et al. is irrelevant as there is another significant difference between the claimed invention and the arrangement disclosed by Fujita et al. that scotches the factual determination that Fujita et al. identically describes the claimed inventions within.

Independent claim 1 recites, *inter alia*:

> said driver can modulate each optical shutter element at a gradient corresponding to a predetermined number of bits, so as to drive the optical shutter element at a gradient ***exceeding*** a maximum gradient at said predetermined number of bits without turning OFF the optical shutter element when driving one line. (Emphasis added)

Thus, independent claim 1 requires that the "driver can modulate each optical shutter element at a gradient corresponding to a predetermined number of bits". The first embodiment uses the driver IC 40 for 64 gradients at 6-bits (page 8 lines 10-11). That is, the predetermined number of bits is 6 in the first embodiment.

Independent claim 1 further recites "so as to drive said each optical shutter element at a gradient exceeding a maximum gradient at said predetermined number of bits". The first embodiment outputs 8-bit images (256 gradients). That is, the first embodiment drives each optical shutter element at a gradient (=256) ***exceeding*** a maximum gradient (=64) at said predetermined number (=6) of bits optical shutter element. For the recited purpose, the driver of the present invention doesn't turn OFF the optical shutter element when driving one line (256-bit in the first embodiment).

In contrast, Fujita et al. uses 6-bit driving circuit and outputs 6-bit (64 gradients) images. That is, the driving circuit of Fujita et al. drives each optical shutter element at a gradient (=64) ***equivalent to*** a maximum gradient (=64) at said predetermined number (=6) of bits. Fujita et al. does **NOT** disclose a driver which drives each optical shutter element at a gradient **exceeding** a maximum gradient, as required by independent claim 1.

Independent claim 11, recites, *inter alia:*

> a driver for modulating the ON time of the electro-optic elements based on the image data by a predetermined number of bits, and driving each of said electro-optic elements at a gradient ***exceeding*** a maximum gradient corresponding

> to the predetermined number of bits without turning OFF the electro-optic elements when driving one line. (Emphasis added)

Thus, independent claim 11 similarly requires that the driver drives each of the electro-optic element at a gradient **exceeding** a maximum gradient corresponding to the predetermined number of bits, which is not disclosed by Fujita et al.

The above argued difference between the claimed device vis-à-vis the device of Fujita et al. undermines the factual determination that Fujita et al. identically describes the inventions of claims 1 and 11 within the meaning of 35 U.S.C. § 102. ***Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc.,*** 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992); ***Kloster Speedsteel AB v. Crucible Inc.,*** 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986). More specifically, each element of claims 1 and 11 is not found in Fujita et al., either expressly described or under principles of inherency.

Applicant, therefore, submits that the imposed rejection of claims 1-3 and 11-14 under 35 U.S.C. § 102 for lack of novelty, as evidenced by Fujita et al., is not factually or legally viable. Consequently, withdrawal of this rejection and the allowance of claims 1-3 and 11-14 is respectfully solicited.

II. Claim 15 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Fujita et al., as applied to claim 11, in view of Pederson et al. (USPN 3,938,144).

However, as claim 11 is patentable over Fujita et al., claim 15 depending from claim 11 is patentable over Fujita et al., even when considered in view of Pederson et al.

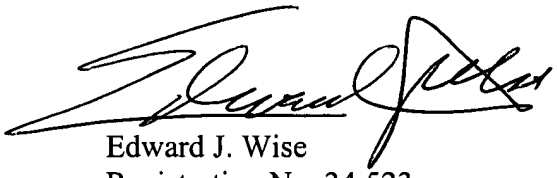
CONCLUSION

Accordingly, it is urged that the application is in condition for allowance, an indication of which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, Examiner is requested to call Applicants' attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY



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